IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventorship .... L. Chiarabini
Assignee .... Hewlett-Packard Company
Group Art Unit 3625
Examiner .... James H. Zurita
Attorney's Docket No. 60004035-3
Title: Method And Apparatus For Automated On-Line Printing Service

AMENDED APPEAL BRIEF UNDER 37 C.F.R. 41.37(d)

To: Honorable Commissioner for Patents
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Pursuant to 37 C.F.R. §41.37, Applicant hereby submits an amended appeal brief for application 09/925,519, filed August 10, 2001, within the requisite time from the Primary Examiner's Notice of Non-Compliance mailed April 16, 2007. Applicant submits that the brief has been amended in the manner requested. Accordingly, Applicant appeals to the Board of Patent Appeals and Interferences seeking review of the Examiner's rejections.

Appeal Brief Items   Page

(1)   Real Party in Interest

The real party in interest is Hewlett-Packard Company, the assignee of all right, title, and interest in and to the subject invention.

(2)   Related Appeals and Interferences

Appellant is not aware of any other appeals, interferences, or judicial proceedings that will directly affect, be directly affected by, or otherwise have a bearing on the Board's decision to this pending appeal.

(3)   Status of Claims

Claims 10 and 27-30 stand rejected and are pending in the Application. Claims 31-38 have been withdrawn. Claims 10 and 27-30 are set forth in the Appendix of Appealed Claims on page 26.

(4)   Status of Amendments

A Response to the final Office Action mailed January 3, 2006 was filed on February 27, 2006. The Response amended one claim that was rejected under 35 U.S.C. §112. An advisory action was mailed on March 29, 2006, advising Applicant that the Response and corresponding amendment were not entered. Applicant filed a Notice of Appeal on June 5, 2006.

(5)   Summary of Claimed Subject Matter

A concise explanation of the independent claim involved in the appeal is included in this Summary section, including specific reference characters, if any.

These specific reference characters are examples of particular elements of the drawings for certain embodiments of the claimed subject matter and the claims are not limited to solely the elements corresponding to these reference characters. Similarly, specific reference to the specification exemplifies the subject matter, although other portions of the specification may also support and describe the claims.

Claim 10 describes a method of providing on-line print services, said method comprising the steps of: receiving at least one order for print products on-line (Page 13, line 14 through Page 14, line 2; Page 14, lines 14-28; Page 16, lines 1-14; Page 17, lines 4-13; Page 17, lines 27-29), said at least one order having an item requiring a particular sheet material (Page 19, lines 15-17); electronically distributing said at least one order to at least one print service provider facility (Page 13, line 30 through Page 14, line 14); within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device (Page 17, line 15 through Page 18, line 22; Page 19, line 11 through Page 22, line 9; Figs. 10 and 11 (1003)); and printing said item according to said order, with said printer device, and on said particular sheet material (Page 17, lines 4-13).

(6)   Grounds of Rejection to be Reviewed on Appeal

Claims 10 and 28-30 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Pub. No. 2003/0140315 to Blumberg et al. (hereinafter "Blumberg").

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Blumberg in light of Official Notice.

Applicant notes that while claim 30 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, this issue is not raised on appeal.

(7)   Argument

A.   The rejections under 35 U.S.C. §102(e) fail to establish that Blumberg anticipates the claims against which it is cited.

Applicant respectfully submits that the Office has not established that the claims rejected under 35 U.S.C. §102(e) are anticipated by Blumberg. The discussion first includes a section entitled "The §102 Standard", which describes the standard by which claim anticipation is established. Next, a section entitled "The Blumberg Reference" describes salient aspects of Blumberg's disclosure. Finally, a section entitled "The Claims" presents Applicant's reasoning as to why the Office has not established that Blumberg anticipates the rejected claims.

The §102 Standard

Applicant notes the requirements of MPEP §2131, which states that to anticipate a claim, the reference must teach "every element" of the claim. This section further states that:
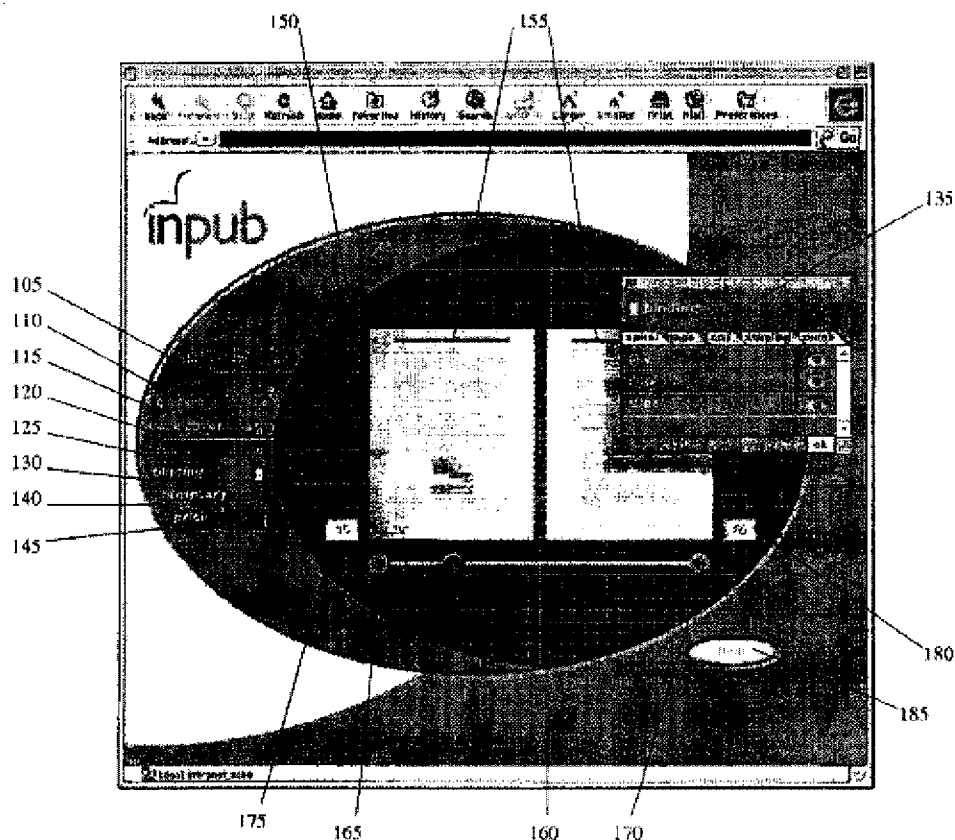
> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913,

1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Accordingly, the reference must contain, within its four corners, exactly the subject matter of the claim, as it appears in the claim, in order to support a valid finding of anticipation. The absence from a cited §102 reference of *any* claimed element negates a finding of anticipation. See, e.g., Kloster Speedsteel AB, et al. v. Crucible, Inc., et al., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

The Blumberg Reference

Blumberg describes a method for creating and viewing, on a computer monitor, content to be printed. The method includes receiving an electronic document, selecting finishing options for the electronic document, and displaying how the electronic document would appear as a finished document, if printed in accordance with the finishing options. Blumberg's Figure 1, which appears on the face of the publication, depicts the user interface of the disclosed "Virtual Builder" viewer software and is displayed below. Blumberg also describes an on-line on-demand printing service. After a user has created a print job with the Virtual Builder software, shown below, the user may order print jobs via a computer network.

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The Claims

Claim 10

Claim 10 recites a method of providing on-line print services, said method comprising the steps of:

- receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;
- electronically distributing said at least one order to at least one print service provider facility;
- within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device; and
- printing said item according to said order, with said printer device, and on said particular sheet material.

In making out a rejection of claim 10, the Office states that Blumberg discloses all of the subject matter of the claim, including "electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device". In particular, the Office states that "Blumberg discloses allocating an item to a printer device based on said printer device having[] said particular sheet material loaded on said printer device. See paragraph[s] 105, 172, for printer devices that print on materials such as clay (mugs), [and] cloth (t-shirts)." (*Office Action of 01/03/06*, p. 6-7). Applicant respectfully but strongly disagrees with the rejection.

Applicant respectfully submits that the Office fails to state a *prima facie* case of anticipation, as the cited portions of Blumberg fail to disclose all of the elements of Applicant's claim. For example, Applicant strongly submits that the Office fails to show how Blumberg discloses "electronically *allocating said item to a printer device* based on said printer device having said *particular sheet material loaded* on said printer device", as recited in claim 10. (emphasis added). In claiming that Blumberg discloses this element, the Office cites Blumberg's paragraphs 105 and 172. Both paragraphs are reproduced below (emphasis added):

> [0105] In a preferred embodiment of the present invention, Virtual Builder invokes different *user interfaces* for different modes of operation, such as standard documents, brochures, business cards, letterheads and mugs.

> * * *

[0172] It should be apparent to those skilled in the art that other specialized *display engines* can be added as necessary for other types of products, such as glossy marketing and advertising materials, t-shirts, mugs and mouse pads.

As the emphasized portions illustrate, the above-cited text does not disclose "allocating [an] item to a printer device", nor does it disclose a "printer device" at all. Instead, these passages relate to the Virtual Builder *software* of Blumberg, which allows products to be *viewed on a monitor*. According to these passages, this software may include "different user interfaces" or "specialized display engines". Applicant respectfully submits that Blumberg cannot be shown to disclose "allocating [an] item to a printer device" when the cited passages make *no mention of a printer device*.

Furthermore, as these passages fail to disclose "allocating [an] item to a printer device", they accordingly fail to disclose "electronically allocating said item to a printer device based on said printer device having said *particular sheet material loaded* on said printer device". While the Office appears to rely on "clay" and "cloth" as the claimed "material", Applicant submits that the cited passages fail to show where these mugs and t-shirts are "*loaded* on [a] printer device". Instead, the passages discuss a specialized display engine that may be configured to view—on a computer monitor—products such as t-shirts or mugs.

Furthermore, the absence of a "loaded" printer device results in the absence of any disclosure concerning the logic recited in the step, namely "electronically *allocating* said item to a printer device *based on* said printer device *having said particular sheet material loaded* on said printer device". However, this infirmity

is superfluous as the passages fail to disclose any sort of "printer device" at all, as discussed above.

In sum, Applicant respectfully submits that the Office's rejection fails to show how Blumberg discloses the elements present in Applicant's claim 10, and also fails to show how Blumberg discloses the logic recited in the step, which requires "electronically *allocating* said item to a printer device *based on* said printer device *having said particular sheet material loaded* on said printer device".

For at least these reasons, Applicant respectfully submits that the Office fails to state a *prima facie* case of anticipation. Applicant therefore requests the withdrawal of the rejection of claim 10.

Claims 28-30 depend from claim 10, and the rejections of these claims is improper for at least the reasons discussed above in regards in their base claim. In addition, these claims recite features that are not disclosed by the cited portions of Blumberg.

Claim 28

Claim 28 recites a method as claimed in claim 10, wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material.

In making out a rejection of this claim, the Office first states that Blumberg discloses "targeting to [a] specific output device such as a color printer", and directs Applicant to Paragraph 132. This passage is reproduced below.

> [0132] Color management is becoming increasingly accurate for matching colors produced on a video display with colors produced by an output device such as a color printer. The International Color Consortium (ICC) has introduced ICC profiles, used to transform

device-dependent colors from one device to another. When an ICC profile is provided for a specific color space, multiple devices can accurately convert color from the specific color space to native device color spaces. Information about ICC profiles is available on the Web, at http://www.color.org. Adobe Acrobat 4 supports ICC profiles embedded within PDF documents.

Applicant respectfully submits that this brief tutorial on color printing fails to relate to "electronically distributing [] based on said at least one print service provider facility being capable of printing on said *particular sheet material*" as recited in Applicant's claim 28. (emphasis added). Assuming, without conceding, that the Office is correct in stating that Blumberg discloses "targeting to [a] specific output device such as a color printer", Applicant submits that such color capabilities of the targeted device are unrelated to the device's ability to print on a "particular sheet material". As such, the Office fails to show this element of Applicant's claim 29.

Furthermore, Applicant respectfully submits that the two other cited passages of Blumberg stray even further from Applicant's claimed subject matter than the passage addressed immediately above. Both passages are reproduced below (emphasis added).

> [0009] The present invention provides an on-line on-demand printing service that enables a user to interactively create and view a finished document, such as a bound book, an eight-page brochure or a customized business card. A user using the present invention can see on his video monitor how a document will look as a finished document, with selected front and back covers, selected binding, selected inserts, selected paper type, size and grain, selected imposition, selected folding, *selected lamination*, selected hole punching, and other selected finishing options. A user using the present invention can also see on his video monitor how a printed product such as a business card will look as a finished document with his own name, company address and logo inserted.

* * *

[0172] It should be apparent to those skilled in the art that other specialized *display engines* can be added as necessary for other types of products, such as glossy marketing and advertising materials, t-shirts, mugs and mouse pads.

Addressing the paragraphs in order, it appears from the Office's reference to "lamination" in the Office Action that this is the portion of paragraph 9 which the Office believes discloses Applicant's claim. Applicant respectfully submits, however, that lamination is not a "particular sheet material", but rather a finishing process that may be done upon a sheet material. The cited portion of Blumberg thus fails to disclose the additional element recited in claim 29.

As for paragraph 172—which Applicant previously addressed above in regards to claim 10—Applicant once more submits this passage only relates to "display engines", which function on a user's computer monitor and do not relate to "electronically allocating" to a "print service provider facility being capable of printing on said particular sheet material".

For at least these additional reasons, Applicant submits that the Office fails to show how Blumberg discloses "wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material." Applicant thus respectfully requests that the rejection of claim 28 be withdrawn.

Claim 29

Claim 29 recites a method as claimed in claim 10, further comprising

- electronically arranging a plurality of virtual print items on at least one virtual media sheet; and
- re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

In making out a rejection of this claim, the Office states that Blumberg discloses all of the elements of this claim. Specifically, the Office instructs Applicant to "[s]ee for example, references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet." (*Office Action of 01/03/06*, p. 7-8). Applicant traverses the rejection.

Applicant strongly submits that the Office fails to state a *prima facie* case of anticipation, as the passages cited by the Office fail to disclose the elements of claim 29. With due respect to the Office's viewpoint, Applicant submits that the first cited passage of Blumberg, paragraph 96, does not address essential elements of Applicant's claim. This passage is reproduced entirely below:

> [0096] To distinguish between selection of a page and selection of a side of a page, the page properties pop-up sheet has two sections. "Side" properties relate to selected sides, and "page" properties related to both the front and back sides of a selected page, regardless of whether one or two sides are selected. When a user selects a page, he can edit the actual media (i.e., the paper) itself, or the printing on a side (i.e., a face) of the page. Media edit options include modification of paper type and lamination, which apply to both sides of a page. Side options include the printing process, such as black & white vs. color reproduction, or the application of a gloss coat in

high-end printing, or scaling of text and graphics, which may be different on the front and back sides of a page.

Applicant submits that the cited passage merely describes "edit options" for Blumberg's Virtual Builder software, from which a user may modify the document on the user's computer monitor. Applicant respectfully submits that this passage fails to relate to the subject matter of Applicant's claim, namely "electronically *arranging a plurality of virtual print items* on at least one virtual media sheet" and "*re-sorting* said plurality of virtual print items amongst said at least one virtual media sheet in a manner which *minimizes a number of cuts*". If the Office disagrees, then Applicant respectfully requests that the Office point out which particular part of Blumberg's paragraph 96 relates to the elements of Applicant's claim.

Applicant further submits that the second portion of Blumberg cited by the Office is equally unavailing. Although the Office does not cite to a particular paragraph, the "eight-page booklet" to which the Office refers only appears in paragraphs 9, 40 and 102. Each paragraph is reproduced below (emphasis added):

> [0009] The present invention provides an on-line on-demand printing service that enables a user to *interactively create and view* a finished document, such as a bound book, an *eight-page brochure* or a customized business card. A user using the present invention can *see on his video monitor how a document will look* as a finished document, with selected front and back covers, selected binding, selected inserts, selected paper type, size and grain, selected imposition, selected folding, selected lamination, selected hole punching, and other selected finishing options. A user using the present invention can also see on his video monitor how a printed product such as a business card will look as a finished document with his own name, company address and logo inserted.
>
> * * *

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[0040] The Internet print on demand service of the present invention also uses finished document *templates that enable a user to view, customize and order personalized printing products*, such as stationary, envelopes, business cards, calendars, greeting cards and invitations. A template includes a pre-constructed set of finishing options that are to be applied to a document. Templates are also used for *creating and ordering types of products having styles that a printing company has pre-designed, such as* folders, flyers, four-page glossy brochures, *eight-page brochures* with cut-outs and inserts, and sixteen-page booklets.

* * *

[0102] Preferably, the library of available styles is based on a selected print facility, since different print facilities typically offer different selections of styles. Use of templates enables a user to create documents with sophisticated styles, without having to create the style himself. In addition, the styles of templates are preferably designed in such a way that they conform to printing and folding operations that are easy to implement. For example, *an eight-page booklet can be produced by printing on a single large page that is folded in half three times*, cutting appropriate folds and stapling twice in the center. In distinction, when a user designs his own style of document, it may be complicated to produce.

Applicant submits that all of the above passages fail to disclose Applicant's claim. At most, these passages of Blumberg disclose that an eight-page brochure may be created by a Virtual Builder user, viewed on the user's computer monitor, ordered by the user, and produced by printing on and folding a page three times. Even assuming that the Blumberg template discloses "electronically arranging a plurality of virtual print items on at least one virtual media sheet", which it does not, nothing in the passage discloses "*re-sorting* said plurality of virtual print items". Again, if the Office disagrees, Applicant respectfully requests that the

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Office point out with more particularity which part of the cited text discloses this element.

Furthermore, while the Office appears to principally rely on the emphasized text of paragraph 102, Applicant submits that this language does not disclose "*re-sorting*", and certainly does not disclose "re-sorting said plurality of virtual print items *in a manner which minimizes a number of cuts*". Instead, Blumberg discloses one way in which an eight-page booklet can be produced—namely printing on a large page and folding it three times. Blumberg does not "re-sort", nor evince a concern for arranging the booklet so as to "minimize a number of cuts". Instead, Blumberg intends to give the Virtual Builder software user the ability to create a booklet in a way which is "easy to implement".

For at least these reasons, the Office fails to state a *prima facie* case of anticipation. Applicant therefore requests the withdrawal of the rejection of claim 29.
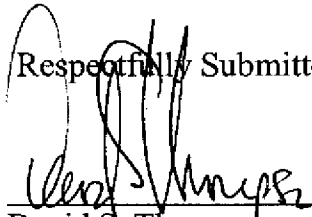
B. The rejections under 35 U.S.C. §103(a) fail to establish that Blumberg in view of Official Notice renders claim 27 obvious.

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Blumberg in view of Official Notice. Claim 27, however, depends from claim 10. Because the "Official Notice" does not cure the deficiencies of the rejection of claim 10, the rejection of claim 27 is improper for least the reasons discussed above in regards to the base claim. Furthermore, claim 27 recites features that are not properly disclosed by the cited portions of Blumberg or by proper Official Notice.

Conclusion

The Office has not established that the claims are anticipated and has failed to establish a *prima facie* case of obviousness. Furthermore, the Office has improperly withdrawn some of Applicant's claims. Accordingly, Applicant respectfully requests that the rejections be overturned, the withheld claims be examined, and all the pending claims be allowed to issue.

Respectfully Submitted,

Dated: 5-17-07

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(8)   Appendix of Appealed Claims

10. (previously presented) A method of providing on-line print services, said method comprising the steps of:

receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;

electronically distributing said at least one order to at least one print service provider facility;

within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device; and

printing said item according to said order, with said printer device, and on said particular sheet material.

27. (previously presented) The method as claimed in claim 10, wherein said particular sheet material comprises canvas.

28. (previously presented) The method as claimed in claim 10, wherein said act of electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material.

29. (previously presented) The method as claimed in claim 10, further comprising:

electronically arranging a plurality of virtual print items on at least one virtual media sheet; and

re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet.

30. (previously presented) The method as claimed in claim 10, wherein said act of electronically allocating allocates said item to said printer device further based on a percentage utilization of said printer device.

(9)   **Evidence appendix. None**

(10) **Related Proceedings appendix. None**